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Birendra N. Agarwala

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03/21/2005

EXAMINER

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SUITE 201

LATHAM, NY 12110

ART UNIT

PAPER NUMBER

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|--------------------------------------|--|--|
| Notification of Non-Compliant Appeal Brief (37 CFR 41.37) | Application No. 09/871,883 | Applicant(s) AGARWALA ET AL. | |
| | Examiner Matthew E. Warren | Art Unit 2815 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 12 June 2003 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file a complete new brief in compliance with 37 CFR 41.37 within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☒ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet.


 TOM THOMAS
 SUPERVISORY PATENT EXAMINER

Continuation of 10. Other (including any explanation in support of the above items): The Board of Appeals found the brief to be defective and remanded the brief to the Examiner for the following reasons:

Specifically, the "SUMMARY OF INVENTION" portion of this brief (see pages 2-6) fails to comply with Section 1.192(c)(5) because no drawing reference characters have been used in explaining the invention defined by the appealed claims. This failure is significantly burdensome to a resolution of the subject appeal. This is because the drawing comprises 17 pages with 33 figures which display various aspects of 4 different embodiments of the appellants' disclosed invention. Further, this burden exacerbated by the fact that 6 independent claims are included in the 27 claims on appeal and by the fact that these appealed claims have been divided by the appellants into 7 distinct groups to be assessed on this appeal (see pages 7-8 of the brief).

In this last mentioned regard, it appears that the brief also is defective in failing to comply with the "GROUPING OF CLAIMS" and the "ARGUMENT" requirements of Section 1.192(c)(7) and (8). That is, the "GROUPING OF CLAIMS" portion of the brief on pages 7-8 appears to be inconsistent with the "ARGUMENT" portion of the brief on pages 9-36. This is because a number of claims which are commonly grouped in the "GROUPING OF CLAIMS" portion of the brief and This is because a number of are grouped and argued separately in the "ARGUMENT" portion of the brief. For example, independent claims 10, 20 and 25 are grouped together in the "GROUPING OF CLAIMS" portion (page 7) but are separately grouped and argued in the "ARGUMENT" section on pages 14-17 (claim 10), pages 19-22 (claim 20), and pages 23-26 (claim 25).

In light of the foregoing, we remand this application so that the examiner can mail to the appellants a notice that their brief is defective for the reasons set forth above. In rectifying these defects, the appellants are required to file a replacement brief which complies with current regulation 37 CFR 41.37 (September 2004) concerning submission of an appeal brief. Section 41.37(c)(1)(v) and (vii) are particularly relevant to the aforementioned defects.

An additional reason compels us to remand this application. On page 10 of the reply brief filed Nov. 14, 2003, the appellants allege that the examiner's answer has not rebutted arguments presented in the principal brief relating to claims 32 and 33 as well as claims 34 and 35. Under the regulation existing at the time this reply brief was filed, the examiner was not permitted to respond to this allegation by way of a supplemental answer. However such a response is expressly permitted by current regulation 37 CFR 5 41.43 (September 2004). Therefore, upon receipt of the appellants' previously discussed replacement brief, the examiner must respond to the allegation in question by preparing a supplemental answer compliant with our current regulation in which he rebuts the arguments concerning claims 32-35 or specifies the portion of his original examiner's answer that he considers to rebut these arguments.